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10/568,465

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Mark Bischoff

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10/15/2010

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3769

MAIL DATE

DELIVERY MODE

10/15/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/568,465 | Applicant(s) BISCHOFF ET AL. | |
| | Examiner david shay | Art Unit 3769 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 16, 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>September 23, 2008</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicant argues that element 11 is depicted as a symbolic representation of a lens, this argument is convincing, however, with regard to elements 15 and H (no argument was made as to element 13) applicant's arguments are not convincing and the objection has been maintained.

Concerning the applied art, applicant argues that the "amendments to the independent claims indicate that the laser radiation scanned by the scanning device across the scanning region illuminates the reference structure located in the adapter beam path such that the reference structure is optically detectable under such illumination" (see the instant response, the first full sentence of the first full paragraph on page 13), however, as claim 22, for example merely claims the adapter, which does not properly include the scanning device, laser or controller, any limitations regarding the behaviors of these various elements are merely intended use, and do not recite further structure of the adapter. Thus with respect to claim 22 and its dependents, these arguments are not convincing. Regarding the remaining independent claims, which recite the entire system, while these arguments are convincing with respect to the Lai (US '401) reference, they are not convincing with respect to Juhasz et al (US '571). As is clear from the disclosure of Juhasz et al (US '571), the laser used to align the contact lens is the surgical laser (see column 3, lines 51-53), and the laser is the laser beam is sequentially directed along a series of paths (see column 4, lines 58-60), the element that does this directing is considered to fall within the broadest reasonable interpretation of the terms "beam scanning unit" and "beam deflecting unit" as used in the claims, the misalignment is then detected and the difference is fed to the control system. Thus this device reads on the claims as amended.

With regard to the rejection under 35 U.S.C. 103(a), applicant argues that the encoder of Grace "does not relate to the type of adapters used in surgery to which the claims are directed"

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(see the instant response, the fifth sentence of the second full paragraph on page 14). This argument is not persuasive for several reasons. Firstly, no particular type of surgery is recited in the claims. Secondly the particular type of surgery, even if claimed is merely the environment in which the device is used and does not relate, per se to the structure of the device. Thirdly, Grace teaches the desirability in general, of transmitting information regarding the configuration of a laser application device to the laser system to which it is attached, that the controller therein may adjust the laser to operate as appropriate to the particular applicator. Thus, as the use of a curved surface applanator will require that the laser be operated differently (e.g. have the focal spots of the beam be placed in a certain way, given the curved configuration thereof, as opposed to the configuration in which they would be placed for a planar applanator), the automatic notification of the controller of this requirement is completely consonant with the teachings one of ordinary skill in the art would derive from Grace.

The drawings are objected to because elements 13, 15, and H are not labeled with indicia indicative of their function. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after

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the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “the adapter being fixatable relative to the laser treatment device via a locking mechanism” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-34, and 37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lai (US ‘401).

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Lai (US '401) teaches a contact glass (see Figure 4a, element 400) with alignment markings (see Figure 4a, element 402, 404, and 406) which allow the laser surgical device to properly steer the beam (see column 19, lines 4-45).

Claims 38, 39, and 41 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lai (US '632).

Lai (US '632) teaches an adapter (see Figure 3, element 109) which has a contact glass (see Figure 3, element 111) which can have alignment markings that allow the laser surgical device to properly steer the beam (see column 9, lines 56-59) and includes a suction port (see column 9, lines 26-30).

Claims 22-32, 37-39, and 41 are rejected under 35 U.S.C. 102(c) as being clearly anticipated by Juhasz et al (US '571).

Juhasz et al (US '571) teach an adapter with reference markings (See Figure 1, elements 30a, 30b, and 30c), which provide information about the position of the contact element. The adjusters can be actuated to move the lens to provide alignment (see column 5, lines 22-52), clearly once alignment is achieved the adjusters are rendered stationary, which is considered to be "locked" as claimed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai (US '401) or Juhasz et al (US '571) in combination with Swinger et al and Grace et al. The teachings

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of Lai (US '401) and Juhasz et al (US '571) are as set forth above. Grace et al teach providing encoding on a coupler that provides information concerning the device through which the laser beam is passed. Swinger et al teach the desirability of providing applanator plates of differing configurations. It would have been obvious to the artisan of ordinary skill to employ various shaped applanator plates, as taught by Swinger et al, since these are useful for different surgeries, as set forth in Swinger et al, and to encode the properties of these different plates thereon, as shown by Grace et al, since the different end shapes will affect the laser beam differently and alter the focus thereof, and to incorporate such encoding into the markings already present in Lai (US '401) and Juhasz et al (US '571), since this would assure that the encoding was truly referring to the particular optical element being employed, since the markings would be on the element itself, thus producing a device such as claimed.

Claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai (US '632) or Juhasz et al (US '571) in combination with Lai (US '401). The teachings of Lai (US '632) and Juhasz et al (US '571) are as set forth above. Lai (US '401) teaches providing encoding on a coupler that provides information regarding the position of the coupler, detecting the location of the markings, and sending the data to the controller to aid the guiding of the laser beam during the surgical procedure. It would have been obvious to the artisan of ordinary skill to employ markings, detector and feedback loop of the type disclosed by Lai (US '401) in the devices of Lai (US '632) and Juhasz et al (US '571), since these are useful in guiding the surgical beam to the proper location in the eye, as taught by Lai (US '401), and to block treatment if the error exceeds a certain value, since this is not critical; is well within the scope of one having ordinary skill in the art; provides no unexpected result; and otherwise the laser beam

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would go to the wrong position, which would be disastrous for the patient's vision, and to employ an attenuated beam from the laser to read the marks, since this would avoid the cost of including and aligning a separate laser, thus producing a device such as claimed.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai (US '632) or Juhasz et al (US '571) in combination with Lai (US '401), as applied to claims 38-41, and further in combination with Swinger et al and Grace et al. Grace et al teach providing encoding on a coupler that provides information concerning the device through which the laser beam is passed. Swinger et al teach the desirability of providing applanator plates of differing configurations. It would have been obvious to the artisan of ordinary skill to employ various shaped applanator plates, as taught by Swinger et al, since these are useful for different surgeries, as set forth in Swinger et al, and to encode the properties of these different plates thereon, as shown by Grace et al, since the different end shapes will affect the laser beam differently and alter the focus thereof, and to incorporate such encoding into the markings already present in Lai (US '401) and Juhasz et al (US '571), since this would assure that the encoding was truly referring to the particular optical element being employed, since the markings would be on the element itself, and to employ an attenuated beam from the laser to read the marks, since this would avoid the cost of including and aligning a separate laser, thus producing a device such as claimed.

Applicant's arguments filed August 16, 2010 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Applicant's arguments with respect to claims 38-43 have been considered but are moot in view of the new ground(s) of rejection.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/
Primary Examiner, Art Unit 3769